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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,178	11/03/2003	Cristina Manu	03797.00622	3590
28319	7590	07/13/2005	EXAMINER	
BANNER & WITCOFF LTD., ATTORNEYS FOR MICROSOFT 1001 G STREET, N.W. ELEVENTH STREET WASHINGTON, DC 20001-4597			TSAI, CAROL S W	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/700,178	Applicant(s) MANU ET AL. 	
	Examiner Carol S. Tsai	Art Unit 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

2. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood:

“Probability curve 302 suggests that parameter values of 2, 4 and 6 are of high interest and the parameter value of 5 is of relatively low interest” described at page 6, paragraph 22, line 4-5 is not understandable. It is not clear to the Examiner what is meant by “parameter value of 2, 4, and 6” because Applicant did not provide a clear and specific definition in Specification disclosed for the Examiner to understand what is meant by “parameter” in applicants’ claimed invention.

“User interface 700 includes a first region 702 that displays an execution matrix of parameter combinations. An input icon 704 is displayed in a second region. A software module 706 may be represented in another region. A user may test a particular parameter value combination by selecting that combination from the execution matrix and dragging that combination to input icon 704. After the software module has operated on the parameter value combination, the results of the operation may be displayed in an output region 708.” described at pages 8-9, paragraph 29, lines 2-8 is understandable. It is not clear to the Examiner how a particular parameter value combination can be tested after

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selecting that combination from the execution matrix and dragging that combination to input icon 704.

“In step 604, the probability curves are converted into probability functions.” described at page 7, paragraph 25, line 1 is not understandable because applicant did not provide a specific and detailed description in the Specification for the Examiner to understand how the probability curves can be converted into probability functions.

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner can understand the invention and may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims 1-17 recite no clearly defined practical application of the claimed method or do not draw a conclusion as to the final end result of testing a software module with parameter combinations. Additionally, the method claims do not fall into either of the “safe harbors” defined in the Guidelines for Computer-Implemented Inventions in that there is no manipulation of measured data representing physical objects or activities

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to achieve a practical application (pre-computer process activity) or the performance of independent physical acts (post-computer process activity). The examiner submits that the claimed process merely solves a model mathematical problem without limitation to a practical application.

Claims 1-17 recites signal analysis that is not tied to any physical structure for converting the probability curves into probability function, combining the probability functions into a combination function, selecting parameter value combinations, and receiving an indication from a user. The Examiner submits that the claimed method consists solely of the manipulation of an abstract idea is not concrete or tangible.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 16, it is not understandable what is meant by “receiving an indication from a user”, since there is no clear and specific indication disclosed in Applicants’ Specification.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "to test" is vague and indefinite. It is not clear to the Examiner what test is intended.

In claim 14, "to test" is vague and indefinite. It is not clear to the Examiner what test is intended.

Response to Arguments

8. Applicant's arguments filed May 3, 2005 have been fully considered but they are not persuasive.

Applicants argue that parameter has a widely well-known meaning to those of ordinary skill in the computer programming art. For example, the following figure and description is from U.S. Patent No. 6,714,952 (See Figure 8 and Col. 11, line 55 - Col 12, line 5.).

The Examiner disagrees with Applicants. it is well known in the art that parameters are input and output arguments used in the software programming language; however, the Applicants do not have any further information for providing essential structural connections between testing hardware and software and the importance of a parameter. In addition, how on skill in the art can see Figure 8 and col. 11, line 55-col. 12, line 5 described and depicted in the U. S. Patent No. 6,714,952 if Applicants do not provide such information in the BACKGROUND.

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Applicants argue that “how a particular parameter value combination can be tested after selecting that combination from the execution matrix and dragging that combination to input icon 704” is not clear to Examiner is because the Examiner confused over the meaning of “parameter”. The Examiner disagrees with Applicants. “The numbers 2, 3 and 4 shown in figure 4 represent parameter values. For example, if an API has input parameters x, y and z. the numbers 2, 3 and 4 represent values for parameters x, y and z respectfully. A software module that is being tested is given the parameter values as inputs and the results are displayed in output region 708” as indicated at page 7, lines 5-8 of Applicants’ REMARLS only indicates that a combination of input parameters x, y, and 2 is selected as input parameters; however, Applicants do not clearly and specifically indicate how a particular parameter value combination can be tested after selecting that combination from the execution matrix and dragging that combination to input icon 704.

Applicants disagreed with the argument of “claims 1-17 recite no clearly practical application of the claimed method or do not draw a conclusion as to the final end result of testing a software module with parameter combination” because the present invention does provide a graphical user interface and method that assist uses in selecting parameter values to test, for example, claim 1 is drawn to a “method of generating a list of parameter value to test” and that the concrete and tangible result produced by the method of claim 1 are “parameter value combinations that result in the combination function exceeding a predetermined probability value.” The Examiner disagrees with Applicants. As mentioned above by Applicants that claim 1 is drawn to a method of **generating a list of parameter value to test**. However, in claim 1, “to test” is vague and indefinite. It is

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not clear to the Examiner what test is intended. Also as mentioned above that the concrete and tangible result produced by the method of claim 1 are parameter value combinations that result in the combination function exceeding a predetermined probability value. However, Applicants do not draw a conclusion as to the final end result of selecting parameter value combinations that result in the combination function exceeding a predetermined probability value for testing, for example, what test is intended and which is a practical, useful result of such test.

Applicants disagreed with the argument of “in claims 1-17 consisting solely of the manipulation of an abstract idea is not concrete or tangible” because claim 1, for example, includes the concrete element of “(a) providing to a user a graphical user interface that includes at least two adjustable probability curves that allow the user to graphically indicate the importance of values of at least first and second parameters. The Examiner disagrees with Applicants. A graphical user interface provided to graphically indicate the importance of values of at least first and second parameters; however, a graphical user interface is not able to provide functions of converting the probability curves into probability function, combining the probability functions into a combination function, and selecting parameter value combinations, and receiving an indication from a user. Therefore, as set forth above in the rejection under 35 USC § 101, Claims 1-17 recites signal analysis that is not tied to any physical structure for converting the probability curves into probability function, combining the probability functions into a combination function, selecting parameter value combinations, and receiving an indication from a user. The Examiner submits that the claimed method consists solely of the manipulation of an abstract idea is not concrete or tangible.

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Applicants disagree with the argument of “receiving an indication from a user” in claim 16 is not understandable” because the feature is described, for example, in paragraph 29 and is illustrated in Figure 7 and that the Applicant respectively submits that after reading paragraph 29 and analyzing Figure 7, one skilled in the art would appreciate that receiving an indication from a user,” may include receiving movement commands at a mouse or other pointing device. The Examiner disagrees with Applicants. In paragraph 29, Applicants do not describe any thing that is related to movement commands at a mouse or other pointing device. In the Figure 7, Applicants also do not depict any thing that is related to movement commands at a mouse or other pointing device. One skill in the art is not able to figure out how an indication can be received from a user if Applicants do not provide clear and detailed description in the Specification. Therefore, as set forth above, in claim 16, it is not understandable what is meant by “receiving an indication from a user”, since there is no clear and specific indication disclosed in Applicants’ Specification.

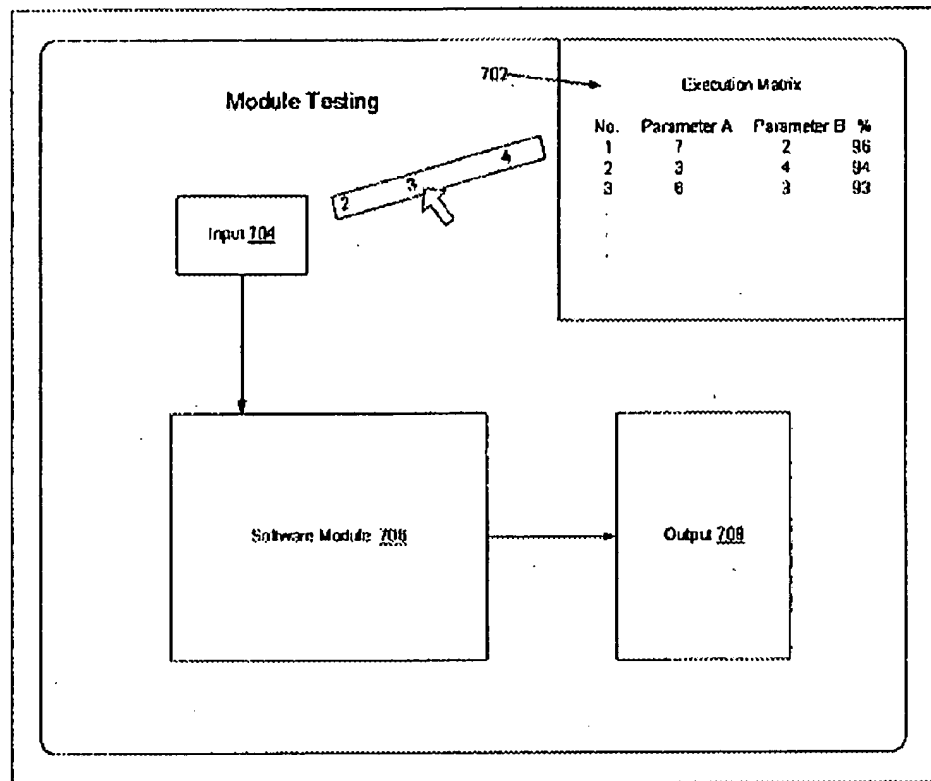


Figure 7

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol S. W. Tsai whose telephone number is (571) 272-2224. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571) 272-2216. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).



Carol S. W. Tsai
Primary Examiner
Art Unit 2857

cswt
July 11, 2005